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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,635	08/24/2001	Jeffrey Green	NA11P091/01.049.01	1384
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Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/935,635

Applicant(s)

GREEN ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 1-9, 11-34, and 36-43 are currently presented and have been examined.

It is noted that a new Examiner has been assigned to this case. Any future inquiries regarding this case should be directed to the new Examiner.

***Response to Arguments***

Applicant's arguments, see the response filed 13 July 2005, with respect to the rejection(s) of claim(s) 1-9, 11-34, and 36-43 under Moloney have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the references listed below.

The Examiner notes, in view of the prosecution history of the application, that the limitation of converting an electronic file from a first file format to a second file format that is different from the first file format to prevent a computer virus in an electronic file from executing when the converted electronic file is opened by an intended recipient as recited in the claims is interpreted to include both the virus being rendered inoperable or being removed from the electronic file based on the specification's definition of this limitation on page 7, paragraph 0017, lines 8-11. Since the claim must be

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interpreted according to its broadest reasonable interpretation as required by MPEP 2111, the Examiner is construing the limitation as noted above. Any specific embodiment must be recited in the claim in order to distinguish the claim from the applied prior art.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

Claim 1 is missing a period at the end of the claim. See MPEP 601.08(m). ("Each claim begins with a capital letter and ends with a period.")

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29, 30, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one

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skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 29 and 37 recite the limitation "determining if the first file format is...a graphics file format type...the second file format being...the HTML file format without scripts...if it is determined that the first file format is the graphics file format type". This limitation is not described in the specification to enable one to make and/or use the invention.

Claim 30 recites the limitation "the certain electronic file received by at least one of a RTP transfer protocol or a HTTP transfer protocol". This limitation is not described in the specification to enable one to make and/or use the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 8-9, 11-21, 23-34, 36-37, and 39-43 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5 889 943 A to Ji et al.

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Regarding claim 1, Ji discloses a method carried out by a computer when executing computer-readable program code, the method comprising:

receiving an electronic file intended for delivery from a sender to an intended recipient; (column 11, line 14-column 12, line 67, specifically column 11, lines 48-52)

determining whether the electronic file represents a potential security risk to a computer system; (column 11, line 14-column 12, line 67, specifically column 12, lines 27-36)

if it is determined that the electronic file represents the potential security risk, then forwarding to the intended recipient a notification indicating that the electronic file represents a potential security risk; (column 20, lines 52-59)

receiving from the intended recipient a request to view the contents of the electronic file; (column 16, lines 38-55)

converting the electronic file from a first file format to a second file format that is different from the first file format and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient, said converting of the electronic file being in response to a determination that the electronic file represents the potential security risk to the computer system;

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(column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67) and

making the converted electronic file available for viewing by the intended recipient. (column 13, lines 15-23)

Regarding claim 2, Ji discloses the method of claim 1, said converting occurring in response to said receiving the request to view the contents of the electronic file. (column 17, lines 29-36)

Regarding claim 3, Ji discloses the method of claim 1, said converting occurring prior to said receiving the request to view the contents of the electronic file. (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67)

Regarding claim 6, Ji discloses a method carried out by a computer when executing computer-readable program code, the method comprising:

receiving a certain electronic file intended for delivery from a sender to an intended recipient; (column 11, line 14-column 12, line 67, specifically column 11, lines 48-52)

converting the certain electronic file from a first file format to a second file format that is different from the first file format and that prevents a computer virus in the certain electronic file from executing when the converted electronic file is opened by the intended recipient, said converting of the

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electronic file being in response to a determination that the electronic file represents a potential risk to the computer (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67), and

making the converted electronic file available for viewing by the intended recipient. (column 13, lines 15-23)

Regarding claim 8, Ji discloses the method of claim 6, said making the converted electronic file available for viewing comprising forwarding the converted electronic file to a computer of the intended recipient. (column 12, lines 47-49; column 13, lines 15-23)

Regarding claim 9, Ji discloses the method of claim 6, said making the converted electronic file available for viewing comprising saving the converted electronic file in a memory that is accessible by the intended recipient. (column 12, lines 47-49; column 13, lines 15-23)

Regarding claim 11, Ji discloses the method of claim 6, said determining whether the certain electronic file represents the potential risk comprising determining if the certain electronic file contains the computer virus. (column 12, lines 27-36)

Regarding claim 12, Ji discloses the method of claim 6, said determining whether the certain electronic file represents



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the potential risk comprising conducting a heuristic scan of the certain electronic file. (column 11, line 54-column 12, line 1)

Regarding claim 13, Ji discloses the method of claim 6, the certain electronic file being an attachment to an electronic mail sent over a network. (column 14, lines 25-45)

Regarding claim 14, Ji discloses the method of claim (3, the network including the internet. (column 2, lines 48-53)

Regarding claim 15, Ji discloses the method of claim 6, said receiving occurring at a desktop computer of the intended recipient. (column 17, lines 18-52)

Regarding claim 16, Ji discloses the method of claim 6, said receiving occurring at a server computer. (column 13, lines 1-14)

Regarding claim 17, Ji discloses the method of claim 6, said receiving occurring at a gateway computer. (column 12, lines 47-49 and 56-59)

Regarding claim 18, Ji discloses the method of claim 6, said converting occurring at a desktop computer of the intended recipient. (column 17, lines 18-52)

Regarding claim 19, Ji discloses the method of claim 6, said converting occurring at a server computer. (column 13, lines 1-14)

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Regarding claim 20, Ji discloses the method of claim 6, said. converting occurring at a gateway computer. (column 12, lines 47-49 and 56-59)

Regarding claim 21, Ji discloses the method of claim 6, the certain electronic file being a first electronic file, further comprising:

receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; (column 11, line 14-column 12, line 67, specifically column 11, lines 48-52)

converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient; (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67) and

making the converted second electronic file available for viewing by the another intended recipient. (column 13, lines 15-23)

Regarding claim 22 The method of claim 6, the computer virus including a macro virus.

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Regarding claim 23-28, Ji discloses the method of claim 6, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GTF file format, a HTML file format without scripts, a file format having text without scripts, and a ASCII file format, the certain electronic file being at least one of a word processing file, a spreadsheet file, a database file, a graphics file, a presentation file, a compressed file, and a binary executable file (column 13, lines 21-23; column 14, lines 30-38; column 20, lines 22-29).

Regarding claim 29, Ji discloses the method of claim 6, further comprising determining if the first file format is one of a word processing file format type and a graphics file format type, the second file; format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the certain file format is the word processing file format type, the second file format being at least one of a JPB file format, a BUT file format, a GIF file format, the HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type. (column 13, lines 21-23; column 14, lines 30-38; column 20, lines 22-29)

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Regarding claim 30, Ji discloses the method of claim 6, the certain electronic file being an electronic file received by at least one of a RTP transfer protocol or a HTTP transfer protocol. (column 2, lines 48-53)

Regarding claim 31, Ji discloses a method comprising:  
receiving a request to view the contents of an electronic file infected with a computer virus; (column 16, lines 38-55)  
and

in response to the request, converting the electronic file from a first format to a second format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened, said converting of the electronic file being in further response to a determination that the electronic file represents a potential security risk to a computer. (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67; column 17, lines 29-36)

Regarding claim 32, Ji discloses the method of claim 31, in further response to the request, making the converted electronic file available for viewing by an entity that requested to view the contents of the certain electronic file. (column 13, lines 15-23)

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Regarding claim 33, Ji discloses a computer-readable medium having instructions stored thereon, the instructions when executed by a computer cause the computer to:

convert an electronic file from a first file format to a second file format, the electronic file being intended for delivery from a sender to an intended recipient, the second file format being different from the first file format and preventing a computer virus in the electronic file from executing; (column 11, line 14-column 12, line 67, specifically column 11, lines 48-52)

when the converted electronic file is opened by an intended recipient of the electronic file, said converting of the electronic file being in response to a determination that the electronic file represents a potential risk to the computer, (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67) and

make the converted electronic file available for viewing by the intended recipient. (column 13, lines 15-23)

Regarding claim 34, Ji discloses the computer-readable medium of claim 33, the certain electronic file being an attachment to an electronic mail sent over a network. (column 14, lines 25-45)

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Regarding claim 36, Ji discloses the computer-readable medium of claim 33 said determining whether the certain electronic file represents the potential risk comprising determining if the certain electronic file contains the computer virus. (column 12, lines 27-36)

Regarding claim 37, Ji discloses the computer-readable medium of claim 33, the instructions when executed by the computer further cause the computer to determine if the first file format is one of a word processing format type and a graphics format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type. (column 13, lines 21-23; column 14, lines 30-38; column 20, lines 22-29)

Regarding claim 39, Ji discloses the computer-readable medium of claim 33, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB

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file format, a GIF file format, a HTML file format without scripts, and a ASCII file format. (column 13, lines 21-23; column 14, lines 30-38; column 20, lines 22-29)

Regarding claim 40, Ji discloses an apparatus comprising:

a computer having means for receiving a certain electronic file intended for delivery from a sender to a intended recipient, the certain electronic file having a first file format and containing a computer virus (column 11, line 14-column 12, line 67, specifically column 11, lines 48-52),

the computer further including means for converting the certain electronic file from the first file format to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient, said converting of the electronic file being in response to a determination that a electronic file represents the potential security risk to the computer, (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67)

the computer further including means for making the converted electronic file available for viewing by the intended recipient. (column 13, lines 15-23)

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Regarding claim 41, Ji discloses the apparatus of claim 40, said computer being a desktop computer of the intended recipient. (column 17, lines 18-52)

Regarding claim 42, Ji discloses the apparatus of claim 40, said computer being a server computer of a local area network. (column 13, lines 1-14)

Regarding claim 43, Ji discloses the apparatus of claim 40, said computer being a gateway computer. (column 12, lines 47-49 and 56-59)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.



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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji in view of US Patent Application Publication 2002/0120693 A1 to Rudd et al.

Regarding claims 4 and 5, Ji discloses a method carried out by a computer when executing computer-readable program code, the method comprising:

receiving an electronic file intended for delivery from a sender to an intended recipient; (column 11, line 14-column 12, line 67, specifically column 11, lines 48-52)

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converting the electronic file from a first file format to a second file format that is different from the first file format and that ensures that a computer virus in the electronic file is unable to harm a computer of the intended recipient, said converting of the electronic file being in response to a determination that the electronic file represents a potential security risk to the computer; (column 11, line 14-column 12, line 67, specifically column 12, lines 47-49 and 56-67)

Ji does not disclose forwarding a uniform resource locator to the intended recipient of the electronic file, the uniform resource locator identifying at least an address of a web page containing the converted electronic file, the second file format being a HTML file format without scripts, however, Rudd does disclose these limitations (paragraph 0028).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Rudd discloses that forwarding a uniform resource locator can be used if the intended recipient uses a web browser (paragraph 0028). In view of these specific advantages and that the references are directed to converting electronic files between formats in order to disable computer viruses, one of ordinary skill would have been motivated to combine these references and would have considered them to be

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analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 7 is also rejected since the motivations regarding the obviousness of claim 4 also apply to claim 7.

Claims 22 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji in view of US Patent 5 832 208 A to Chen et al.

Regarding claim 22, Ji discloses the method of claim 6.

Ji does not disclose the computer virus including a macro virus, however, Chen does disclose this limitation (column 2, lines 18-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Chen discloses that macro viruses are spread via file transfer including email and their destructive behavior is able to be stopped by intermediary virus scanners between a sender and a recipient of a message (column 2, lines 18-34; column 3, line 48-column 4, line 30). In view of these specific advantages and that the references are directed to using intermediary virus scanners to disable and/or eliminate virus transmitted over a network, one of ordinary skill would have been motivated to combine these references and would have

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considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 38 is also rejected since the motivations regarding the obviousness of claim 22 also apply to claim 38.

### ***Conclusion***

The following prior art listed in the PTO-892 form included with this Office Action discloses methods, systems, and/or apparatuses similar to those claimed and recited in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

A handwritten signature in black ink, appearing to read "Wm. C. Vaughn, Jr.", with a large, stylized flourish at the end.

**WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER**